

**REMARKS/ARGUMENTS**

***Amendments in General / Claim Rejections - 35 U.S.C. § 112***

1. The Abstract has been modified to include less than 150 words.
2. Claims 1, 2, 42, 43, 53-60, and 67 are rejected by the Examiner under the first paragraph of 35 U.S.C. §112.

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

Accordingly, favorable reconsideration and withdrawal of the rejection of Claims 1, 2, 42, 43, 53-60, and 67 under the first paragraph of 35 U.S.C. §112 are respectfully requested. In the event that the Office maintains this possession rejection, Applicant respectfully requests, in accordance with the principles of compact prosecution, that the Office articulate, one the record and with specificity sufficient to support a case of a written description rejection, the factual basis on which it is alleged that it would be beyond the level of ordinary skill in the art to recognize in the Applicant's disclosure a description of the invention defined by the claims (MPEP §2163.04), and in particular what items of said claims are rejected to, i.e. claim 42 is an original claim.

3. Claims 2, 4, and 43 rejected by the Examiner under the second paragraph of 35 U.S.C. §112.
4. The Examiner stated that Claim 2 is not clear whether "water sprays" are part of the claimed invention and also states it is not clear what value would be considered "approximately no more than 1,350 psig".

During cleaning procedures as outlined in the specification (pg. 14, para. 2) the light assembly may be exposed to pressurized water. While the “water spray” is not directly part of the invention, the configuration of maintaining operational integrity under such water pressure is. Therefore the term “water spray” has been changed to “water pressure” in claim 1.

Further claim one has been modified to no longer contain the term approximately to add clarity.

5. The Examiner stated that Claim 4 is not clear whether “water sprays” are part of the claimed invention and also states it is not clear what value would be considered “approximately no more than 200”.

During cleaning procedures as outlined in the specification (pg. 14, para. 2) the light assembly may be exposed to heated, pressurized water. While the “water sprays” is not directly part of the invention, the configuration of maintaining operational integrity under such water pressure is. Therefore the term “water sprays” has been changed to “water pressure” in claim 4.

Further claim one has been modified to no longer contain the term approximately to add clarity.

6. The Examiner stated that Claim 43 is not clear as to how one would perform more than a majority in this instance. Claim 43 has been modified to add clarity.

### **Standards for Patentability**

7. “An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent .... In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct.” *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Judge Plager concurring).

### ***Claim Rejections - 35 USC § 103***

8. The Examiner rejected claims 1-10, 12-15, 18-20, 22-29, 31, 32, 53-55, 59 and 67 under §103(a) as being unpatentable (obvious) over Pat. No. 5,597,597 (Newman), in view of US 2002/0168287 (Eckhardt), in further view of Pat. No. 5,910,332 (Fakieh), in further view of Pat. No. 6,675,437 (York).
9. The Examiner rejected claims 11, 16, 17, 21, 30, 56-58, and 60 under §103(a) as being unpatentable (obvious) over Pat. No. 5,597,597 (Newman), in view of US 2002/0168287 (Eckhardt), in further view of Pat. No. 5,910,332 (Fakieh), in further view of Pat. No. 5,400,382 (Welt). The Applicant assumes Pat. No. 5,400,382 to Welt is the cited patent, as the Office Action states “5,40,382”, and Welt is not in the list of references cited.

#### **I. Prima Facie Obviousness**

In order to sustain a rejection of the claims under §103(a), an examiner must initially put forth his/her *prima facie* case of obviousness. The Federal Circuit has made it clear that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

Only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will only be analogous art if: 1) it is from the same field of endeavor as the claimed invention; or 2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir.

1992). In the *In re Clay* case, the subject claims were directed to a process which improved removal of oil products from storage tanks. The Examiner in that case cited a patent directed to improving production of oil from underground formations. The Federal Circuit held that the cited patent as not analogous art even though the cited patent and subject application both related to the oil industry.

Eckhardt, Fakieh, and York are not within the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve a problem of would not reasonably be expected or motivated to look to cooking rotisseries, or medical grade sanitizers, or pressure washers.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art (or "It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art):

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The prior art teaches away from the present invention. One would not be motivated to utilize medical grade sanitation devices to sterilize food, nor look to rotisserie cooking apparatuses for sterilization purposes. The combination of these four, very distinct, separate items of art is completely unmotivated.

The prior art must show reasonable expectations of success.

"Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

"Obvious to try or to experiment is not sufficient." *Yamanouchi Pharmaceutical Co., Ltd. v. Marsam Pharmaceuticals, Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000).

It is submitted that the combination of Newman, Eckhardt, Fakieh, and York, or the combination of Newman, Eckhardt, Fakieh, and Welt, is not suggested by the prior art, and even if such combinations were to be made, one would not be led to the combination of features recited in applicant's claims. In particular, the references would not sterilize the items properly as the style of rotisserie as taught by Fakieh would provide shadowing and not sterilize food items completely all around said food items as the current application does.

It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicant's specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecated the claimed invention.' [citations omitted]

*In re Fritch*, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references “must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention.” *Akzo N.V. v. United States Int’l Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

Newman, Eckhardt, Fakieh, and York are complete and functional without the need for modification. Absent the need for modification to provide functionality, the references could never lead one to make modifications to meet the claims. Further, the fact that such a vast reaching and large amount of prior art was needed to compile and attempt a recreation of the present application further expresses the non-obvious nature of the present application.

This suggestion for modification must be **motivating**.

“The prior art must provide one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.”

*In re Jones*, 21 USPQ2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

Even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the **desirability** for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (“mere fact that prior art may be modified to reflect features of claimed invention does not make the modification, and hence, the claimed invention, obvious unless the desirability of such a modification is suggested by prior art). Citing *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.

Moreover, the motivating suggestion must also be **explicit**. An invention cannot be found obvious unless there is “some **explicit** teaching or suggestion in art to motivate one of even ordinary skill to combine such elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998).

The Applicant respectfully submits that Claims 1 and 67 are not suggested by the combination of Newman, Eckhardt, Fakieh, and York, and therefore not obvious. Further there is no motivation or explicit teaching to combine Newman, Eckhardt, Fakieh, and York. A person having ordinary skill in the art would not be compared to look into the separate technologies of rotisserie cookers, medical tool sterilization, and pressure washers when considering a problem of removing organic contamination on foodstuffs with UV light.

The applicant also respectfully submits that Claim 1 is not suggested by the combination of Newman, Eckhardt, Fakieh, and Welt, and therefore not obvious. Further there is no motivation or explicit teaching to combine Newman, Eckhardt, Fakieh, and Welt. A person having ordinary skill in the art would not be compared to look into the separate technologies of rotisserie cookers, medical tool sterilization, and large scale gamma ray bombardment plants when considering the problem of removing organic contamination on foodstuffs with UV light.

For Claim 1, which claims 2-10, 12-15, 18-20, 22-29, 31, 32, 53-55, 59 depend upon, it is not obvious to combine the teaching of Newman, Eckhardt, Fakieh, and York. Therefore claims 2-10, 12-15, 18-20, 22-29, 31, 32, 53-55, 59 are not obvious in light of Newman, Eckhardt, Fakieh, and York.

For Claim 1, which claims 11, 16, 17, 21, 30, 56-58, and 60 depend upon, it is not obvious to combine the teaching of Newman, Eckhardt, Fakieh, and Welt. Therefore claims 11, 16, 17, 21, 30, 56-58, and 60 are not obvious in light of Newman, Eckhardt, Fakieh, and Welt.

### ***Conclusion***

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 23<sup>rd</sup> day of May, 2008.

Very respectfully,

/Frank J. Dykas/  
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Examiner: Drew Becker  
Serial # 10/614,320

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**CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 CFR 1.8**

I HEREBY CERTIFY that this correspondence is being transmitted to the United States Patent and Trademark Office by EFS-Web on the date below.

DATED: This 23<sup>rd</sup> day of May, 2008.

/Julie L. O'Tyson/  
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